

REMARKS

Claims 1 – 15, 17 and 18 are pending in the application and are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, claims 1 – 6 were withdrawn from the present application pursuant to a restriction requirement; the specification was objected to with respect to the arrangement thereof and reference to claim numbers within; the drawings were objected to as not properly representing the prior art and not properly referring to reference numerals; claims 7 and 14 were objected to as not reciting positive limitations; claim 16 was objected to as being in an improper dependent form; claims 8 – 14 and 16 were rejected under 35 U.S.C. §112, second paragraph as being indefinite; claims 7 – 16 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent no. 5,672,300 to Schurig et al.; claims 7 – 12, 15, and 16 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. patent no. 3,274,676 to Krystof; and claims 7 – 12, 15 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Krystof in view of U.S. patent no. 6,631,016 to Hay, II.

By this Response and Amendment, the Applicants note the Examiner's withdrawal of claims 1 – 6 from further consideration;

the specification has been amended to include reference numbers 19 and 26 and a replacement Fig. 1 has been submitted, which now more particularly shows the element corresponding to reference numeral 13; the Examiner's remaining objection to the drawings has been traversed;

the specification has been amended to delete reference to specific claim numbers and to add section headings as suggested by the Examiner;

claims 8 – 10 have been amended to depend from claim 7 rather than claim 1; claim 14 has been amended to delete the wording: “may intersect” and replace it with: “are capable of intersecting,” thereby positively reciting the limitation; claim 16 has been canceled; claim 17 has been newly added to further limit the structure recited in claim 7; independent claim 18 has been added to recite a “nozzle mounted to a ball-and-socket bearing;” claims 7 – 15 have been amended to remove reference numerals; and

the prior art rejections of claims 7 - 16 are traversed and arguments in support thereof are provided.

It is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. § 132. Support for the amendments to the claims is found throughout the specification. Particularly, support for of the ball-and-socket limitation of newly added claim 18 is found in paragraph 0013 of published patent application 20010010038160 and support for newly added claim 17 is found in Fig. 1.

Restriction Requirement

The Examiner made the previous restriction requirement final and withdrew all of claims 1 – 6 from further consideration.

Response

Applicants note the Examiner’s Final restriction requirement and withdrawal of claims 1 – 6 from the present application without prejudice.

Objection to the Drawings

The Examiner objected to the drawings asserting that Fig. 1 is not properly designated as prior art; Figs. 2 and 3 include reference numbers not included in the description; and reference number "13" does not properly designate the second mass in Fig. 1.

Response

By this Response and Amendment, the specification has been amended to include reference numbers 19 and 26 and a replacement Fig. 1 has been submitted; Applicant respectfully traverses the Examiner's remaining objection.

Contrary to the opinion of the Examiner, Fig. 1 should not be designated as showing the prior art. Even though the basic principles of a rotary die machine are well known, Fig. 1 shows the practical application of the casting device according to the invention. Specifically, reference numeral 2 of Fig 1 is an embodiment of the present invention shown in relation to these basic principles of the rotary die machine. Reference numeral 2 again refers to the present invention in Fig. 2 and is so stated in lines 29 – 30 of page 6 of the present application as an embodiment of the present invention. Therefore, Fig. 1 depicts the present invention rather than the prior art.

Accordingly, reconsideration and withdrawal of the objections is respectfully requested.

Objection to the Specification

The Examiner objected to the specification as improperly referring to specific claim numbers and for not containing proper headings.

Response

Applicants thank the Examiner for his suggestions. By this Response and Amendment, the specification has been amended to delete reference to specific claim numbers and to add section headings as suggested by the Examiner. Therefore, the Examiner's objection is obviated and Applicants respectfully request the Examiner to withdraw the objection.

Claim Objections

The Examiner objected to claims 7 and 14 as not reciting positive limitations and to claim 16 as failing to further limit the subject matter of a previous claim.

Response

By this Response and Amendment, claim 7 has been amended to more positively recite "a biopolymer" and "a cooling device." Claim 14 has been amended to delete the wording: "may intersect" and replace it with: "are capable of intersecting," thereby positively reciting the limitation. Claim 16 has been canceled thereby rendering the Examiner's rejection thereto moot and claim 17 has been newly added to further limit the structure recited in claim 7.

As herein amended, Applicants respectfully request reconsideration and withdrawal of the objections to the claims 7 and 14.

Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 8 – 14 and 16 under 35 U.S.C. §112, second paragraph as being indefinite.

Response

Applicants thank the Examiner for the suggested corrections. Accordingly, Applicants have amended claims 8 – 10 to depend from claim 7 rather than claim 1. It then follows that the ultimate dependency of claims 11 – 14 has also been corrected to depend from claim 7 rather than claim 1.

Also, claim 13 has been amended as suggested by the Examiner to replace the term “supply” with – feed –. Claim 16 has been canceled thereby rendering the Examiner’s rejection thereto moot.

Accordingly, in light of these amendments, reconsideration and withdrawal of the rejections is respectfully requested.

Rejection under 35 U.S.C. § 102(b): Schurig et al.

Claims 7 - 16 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent no. 5,672,300 to Schurig et al.

Response

Claim 16 has been canceled thereby rendering its rejection moot. By this Response and Amendment, Applicants respectfully traverse the Examiner’s rejections.

The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim.

Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir.

1990).

Schurig et al. teaches combining two different spreader boxes in such a way that the inner surface of a first spreader box and the outer surface of a second spreader box form a gap through which a base gelatine ribbon may flow. The second gelatine mass may flow *onto* the base gelatine ribbon. According to Schurig, the second spreader box is provided with an opening for the second gelatine mass. But, the opening is configured such that the second mass will be deposited on – rather than *in* – the first gelatine mass.

In contrast, according to amended claim 7, the feed device for the second mass of the present invention is an injection nozzle, which is located within the casting gap of the casting container. The term “injection” implies that it is not intended to form different layers by the different masses. The nozzle is positioned so that the second mass will be fully enveloped by the first mass. Again, this is contrary to Schurig et al. who teach that the second gelatine mass will flow *onto* the base ribbon. (*see* ‘300 patent col. 5, lines 2 – 3).

Also, the use of a nozzle in the present invention differs from Schurig et al. in that Schurig et al. teach a second container with an opening, but they make no mention of a *nozzle* that injects the second gelatine material inside the first gelatine material.

In view of the above, Applicants respectfully submit that the ‘300 patent does not disclose each and every element as set forth in amended claim 7. Claim 7 is therefore asserted to be patentable over the ‘300 patent. Claims 8 – 15 and newly added claim 17, each ultimately dependent from claim 7, are asserted to be patentable over the ‘300 patent for at least the same reasons that claim 7 is patentable thereover.

Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

Rejection under 35 U.S.C. § 102(b): Krystof

Claims 7 – 12, 15 and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent no. 3,274,646 to Krystof.

Response

Claim 16 has been rejected thereby rendering its rejection moot. By this Response and Amendment, Applicants respectfully traverse the Examiner's rejections.

The Examiner has not shown that all of the elements of amended independent claim 7 are present in the prior art. The Examiner notes that Krystof teaches an apparatus for making extruded sheet material, which has two extruders for making the material. However, Kristoff does not teach the extrusion of the material onto a cooling device. Contrastingly, claim 7 of the present application recites “a cooling device under the casting gap, wherein the two masses in the flowable condition are together poured out onto the cooling device.” Kristoff does not show this. Assuming *arguendo* that cooling of the extruded material is inherent, Kristoff is silent as to where, in relation to the ejection of the material, the cooling occurs. In the present invention, as claimed in amended claim 7, the cooling device is located outside the casting container under the casting gap.

The Examiner indirectly concedes the Applicants' argument by making an obviousness rejection, *infra*, to Krystof in view of Hay, II. Therein, the Examiner states that “Krystof (-646) discloses the device substantially as claimed as mentioned above, *except for a cooling device.*” *Office action* at 13 (emphasis added). The Examiner cannot have it both ways. Since the Examiner concedes that the claimed cooling device is not shown in the cited reference, it follows that the reference cannot anticipate the claimed invention.

Moreover, Krystof discloses a nozzle whose casting gap is not positioned within the

casting gap of the casting container as claimed in amended claim 7. Rather, it is positioned upstream of the casting container's casting gap. Contrarily, in the present invention, the nozzles open out in a region *within* the casting gap of the casting container. The Examiner concedes this argument by stating that “[t]he openings of the injection nozzle 116a, 116b are displaced back relative to the plane of the casting gap 36, 32.” *Office action* at 12.

In view of the above, Applicants respectfully submit that the ‘646 patent does not disclose each and every element as set forth in amended claim 7. Amended claim 7 is therefore asserted to be patentable over the ‘646 patent. Claims 8 – 15 and newly added claim 17, each ultimately dependent from amended claim 7, are asserted to be patentable over the ‘646 patent for at least the same reasons that claim 7 is patentable thereover.

Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 7 – 12, 15 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Krystof in view of U.S. patent no. 6,631,016 to Hay, II.

Response

By this Response and Amendment, Applicants respectfully traverse the Examiner's rejections.

Applicants traverse the rejections because all three prongs for a *prima facie* case of obviousness have not been established for each of the rejections. Specifically, all the claim limitations are not present in the cited references and that even if combined as suggested by the Examiner the combination would not result in the present invention as claimed.

For a reference or references to render an invention obvious, the Examiner must establish: (1)

that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991).

Hay, II discloses a film casting apparatus including a heat transfer roller. The purpose of this heat transfer roller is to cool down a freshly formed synthetic resinous film 13, which is extruded by a sheeting die. Hay, II is directed toward extrusion of a thin film material.

However, as stated above with respect to the Examiner's rejection under 35 U.S.C. §102(b), Krystof does not disclose a nozzle whose casting gap is positioned within the casting gap of the casting container. Rather, Krystof's nozzle is positioned upstream of the casting container's casting gap. Contrarily, in the present invention, the nozzles open out in a region *within* the casting gap of the casting container as claimed in amended claim 7. Again, the Examiner conceded that “[t]he openings of the injection nozzle 116a, 116b are displaced back relative to the plane of the casting gap 36, 32.” *Office action* at 12. Neither Krystof nor Hay, II teach or suggest this limitation alone or in combination.. As such, the present invention is patentable over Krystof in view of Hay, II.

MISCELLANEOUS

Independent claim 18 has been added to recite a “nozzle mounted to a ball-and-socket bearing.” Newly added claim 18 contains all of the limitations of amended claim 7; therefore, claim 18 is patentable for at least the same reasons as amended claim 7.

The references cited by the Examiner have been reviewed and it is Applicants' position that the claims as amended are patentable thereover.

CONCLUSION

In light of the foregoing, Applicants submit that the application is in condition for allowance.

If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Respectfully submitted,

NATH & ASSOCIATES PLLC

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NATH & ASSOCIATES PLLC
1030 Fifteenth Street, N.W.
Sixth Floor
Washington, DC 20005
(202) 775-8383



Gary M. Nath
Registration No. 26,965
Marvin C. Berkowitz
Registration No. 47,421
Derek Richmond
Registration No. 45,771